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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,793

03/30/2005

Holger Winkler

MERCK-2993

1498

23599 7590 08/25/2009  
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EXAMINER

VARGOT, MATHIEU D

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

08/25/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,793	<b>Applicant(s)</b> WINKLER ET AL.	
	<b>Examiner</b> Mathieu D. Vargot	<b>Art Unit</b> 1791	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/26/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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1. Based on the amendment formerly withdrawn claims 1-6 have been rejoined and an action hereby follows on all the claims.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 10-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth in paragraphs 0003-0012 and paragraph 0019 essentially for reasons of record noting the following. While claims 1-6 have been rejoined and the admitted prior art as the primary reference has been broadened to include paragraphs 0003-0012, the rejection remains essentially the same. Given that the instant core/shell particles are known in the art, and that such particles are polymers, it would of course have been obvious to have used them for the polymer spheres/particles used in the admitted prior art. Also, if it is known to remove the spheres/particles of the admitted prior art to form the inverse opals, then it surely would have been obvious to have removed any of the core, the shell or both of these when forming the inverse opals of the combination as applied. Employing an interlayer to bond a core and shell together is conventional in the art and would have been obvious to ensure the core/shell particles stay united until their presence is no longer needed—ie, they are removed. The exact ratio of the core to shell in the core/shell particles and the degree of crosslinking in the particles would have been within the skill level of the art dependent on the exact conditions employed to remove the particles to form the inverse

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opal structure. Newly added claim 15 is found at instant paragraph 0008; claim 18 can be found at instant paragraph 0009, both paragraphs disclosing admitted prior art being used as the primary reference in the rejection.

3. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth in paragraphs 0003-0008 and paragraph 0019 essentially for reasons of record as set forth in paragraph 2 supra and paragraph 4 of the last office action.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-17 of copending Application No. 10/590,506 in view of the admitted prior art as set forth in paragraphs 0003-0012 and 0019 for reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5.Applicant's arguments filed May 26, 2009 have been fully considered but they are not persuasive. Applicant's comments concerning the art rejection are submitted to not be probative. If it is known to use polymeric particles to make inverse opal structures, and the particles are removed during the process, then it is submitted prime facie obvious to employ other known polymeric particles—such as the core/shell particles taught at instant paragraph 0019 as admitted prior art—to make the inverse opal structures. There is simply no reason why one of ordinary skill in the art would not do this, contrary to applicant's assertion. One might use the core/shell particles for any number of reasons, but the fact that the prior art uses polymeric particles and the instant core/shell polymeric particles are known renders their use as prime facie obvious. While applicant points to a number of attendant advantages realized when using the core/shell particles, it is not clear that any of these constitute unexpected results. In the absence of such, it is respectfully maintained that the use of core/shell particles in the formation of inverse opal structures would have been obvious. The double patenting rejection has been maintained over the only application still pending—10/590,506-- while the rejections over previously issued US patents 7,291,394 and 7,241,502 have been dropped.

6.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot  
August 16, 2009

/Mathieu D. Vargot/  
Primary Examiner, Art Unit 1791